

Patent Application
Attorney Docket No. PC9344B

REMARKS

Request For Withdrawal of Premature Final Rejection

Applicants respectfully submit that the finality of the Office Action mailed April 21, 2005 was premature. In response to the previous final Office Action of January 11, 2005, applicants filed a response on March 5, 2005. The response of March 5, 2005 was filed along with a Request for Continued Examination (RCE), a supplemental information disclosure statement (IDS) and an associate power of attorney. In the response of March 5, 2005, applicants amended the claims by canceling rejected claims 73-75, 79-80, 84-89 and 92-108, thereby leaving only the previously allowed claims 1-4, 6-14, 16-30, 33-42, 45-50, 52-55, 57-62, 65-69 and 72.

The Examiner then finally rejected claims 1-4, 6-14, 16-30, 33-42, 45-50, 52, 54-55, 57, 62 and 65 in the Office Action mailed April 21, 2005. In addition, the Examiner objected to claims 7, 10, 13-14, 16-29, 48 and 53 as now being dependent on a rejected base claim. Applicants submit that the present rejection of the instant claims was based upon new grounds of rejection over a reference that had been previously considered and over which the Examiner had previously allowed claims 1-4, 6-14, 16-30, 33-42, 45-50, 52-55, 57-62, 65-69 and 72.

The Examiner stated at page 6 of the final Office Action of April 26, 2005 that "5. Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on 3-15-2005 prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL." Applicants are perplexed by this statement since applicants made no statement whatsoever with respect to 35 U.S.C. 103(c) in the response filed on March 5, 2005. In the remarks section of the response filed March 5, 2005 (see page 11) applicants stated merely that previously rejected claims 73-75, 79-80, 84-89 and 92-108 had been canceled and that the rejection of these claims was therefore moot. Applicants respectfully submit that the Examiner raised the new grounds of rejection against claims 1-4, 6-14, 16-30, 33-42, 45-50, 52, 54-55, 57, 62 and 65 over a previously considered reference. Applicants submit that the finality of the rejection mailed April 21, 2005 is therefore premature and should be withdrawn.

Applicants respectfully request the Examiner to reconsider and withdraw the finality of the rejection mailed on April 21, 2005 in view of the foregoing remarks.

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The 35 U.S.C. §103(a) Rejection

Claims 1-4, 6, 8-9, 11-12, 30, 33, 46-50, 52, 54-55, 57-62 and 65 have been rejected as allegedly being obvious over Carpino et al. (U.S. Patent 6,110,932, issued 8/29/2000, hereinafter the '932 patent) and claiming priority to USSN 60/009,469, filed December 28, 1995. Applicants respectfully traverse this rejection.

The Patent Office has applied the '932 patent under 35 U.S.C. §102(a), citing the issuance date of August 29, 2000 for its availability as prior art. Office Action, p. 3-4. Applicants respectfully submit that the instant application claims priority to USSN 60/012,412, which was filed on February 28, 1996. Instant claims 1-4, 6, 8-9, 11-12, 30, 33, 46-50, 52, 54-55, 57-62 and 65 are supported in the priority document. Applicants further submit that USSN 60/012,412, filed on February 28, 1996, renders the '932 patent ineffective as prior art under §102(a) since the priority document shows that the invention of the instant claims was made before the publication of the '932 patent on August 29, 2000. Thus, the '932 patent is not prior art under 35 U.S.C. §102(a) or §103(a) against the instant application. Applicants respectfully request that the Examiner reconsider and withdraw the present 35 U.S.C. §103(a) rejection of claims 1-4, 6, 8-9, 11-12, 30, 33, 46-50, 52, 54-55, 57-62 and 65.

The Examiner stated at page 6 of the final Office Action of April 26, 2005 that "5. Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on 3-15-2005 prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Although instant claims 1-4, 6, 8-9, 11-12, 30, 33, 46-50, 52, 54-55, 57-62 and 65 have not been explicitly rejected under 35 U.S.C. §103(a) based upon the 35 U.S.C. §102(e) date of the '932 reference, Applicants are addressing this issue in order to obviate such a rejection. The '932 patent issued on August 29, 2000 and claims priority to USSN 60/009,469, filed December 28, 1995. The instant application claims priority to USSN 60/012,412, filed on February 28, 1996.

Applicants submit that the '932 patent is not valid prior art against the present application. 35 U.S.C. § 103(c) provides that "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was

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made, owned by the same person or subject to an obligation of assignment to the same person."

Statement of Common Ownership

U.S. Patent Application Serial No. 09/736,051 and U.S. Patent 6,110,932 were, at the time the invention of U.S. Patent Application Serial No. 09/736,051 was made, owned or under an obligation of assignment to Pfizer Inc.

The '932 patent was not publicly available until August 29, 2000, which is after the priority date of the present application, which claims the benefit of USSN 60/012,412, filed on February 28, 1996. Furthermore, both the '932 patent and the present application are commonly owned and assigned. All rights to the present application are entirely owned by and assigned to Pfizer Inc. and the assignment was recorded at the USPTO. All rights to the '932 patent, U.S. Patent 6,110,932, are entirely owned by and assigned to Pfizer Inc. and the assignment was also recorded at the USPTO.

At the time the present invention was made, both the subject matter of the '932 patent (U.S. 6,110,932) and the subject matter of the present application were owned or subject to an obligation of assignment to Pfizer Inc. A conspicuous statement of this fact has been provided hereinabove. Applicants therefore submit that the '932 patent is not valid prior art against the present application under 35 U.S.C. § 103(c). For this reason, Applicants respectfully request the Examiner to reconsider and withdraw the 35 U.S.C. § 103(a) rejection of claims 1-4, 6, 8-9, 11-12, 30, 33, 46-50, 52, 54-55, 57-62 and 65.

Objections to the Claims

Claims 7, 10, 13, 14, 16-29, 48 and 53 have been objected to as being dependent on rejected base claims. Applicants respectfully traverse this objection.

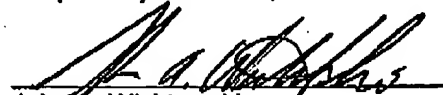
Applicants submit that the claims from which claims 7, 10, 13, 14, 16-29, 48 and 53 depend are in condition for allowance in view of the remarks above. For this reason, Applicants respectfully request the Examiner to reconsider and withdraw the objection to claims 7, 10, 13, 14, 16-29, 48 and 53.

In view of the foregoing remarks, Applicants believe this application is in condition for allowance. An early and favorable response is earnestly solicited.

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Respectfully submitted,

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